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10-11-06

PATENT

AP/3629/15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: R. Mark Halligan

Art Unit: 3629

Serial No.: 09/757,206

Filed: January 9, 2001

For: METHOD AND APPARATUS FOR DOCUMENTATION, ANALYSIS,  
AUDITING, ACCOUNTING, PROTECTION, REGISTRATION,  
AND VERIFICATION OF TRADE SECRETS

Examiner: Mooneyham, J.

Attorney  
Docket No.: 77901-1

APPELLANT'S BRIEF UNDER 37 CFR §1.192

Mail Stop: Appeal Brief  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the final rejection of July 31, 2006 and  
in support of the applicant's Notice of Appeal filed August 16,  
2006, the applicant requests consideration of the following:

I. Real Party in Interest.

The real party in interest is TSO, Inc., by assignment  
dated January 5, 2001 and recorded at Reel/Frame 11494/0155.

II. Related Appeals and Interferences.

None.

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01 FC:2402  
02 FC:2202

III.        Status of Claims.

Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement because the specification does not disclose adequate structure. Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement because the means for doing the step is a human. Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement because the claimed invention is not supported by a specific or well known utility. Claims 1-70 and 119-123 have been rejected under 35 U.S.C. §101 for failing to produce a useful, concrete and tangible result. Claims 1, 3-35, 37-39, 43, 44, 47-57, 60-63, 67-70 and 121 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,263,314 to Donner. Claims 1-41, 43, 44, 47-57, 60-63, 67-70 and 121 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,393,406 to Eder. Claims 42, 45, 46, 58, 59 and 64-66 have been rejected under 35 U.S.C. §103(a) as being obvious over Donner and Eder in view of U.S. Pat. No. 5,136,646 to Haber. Claims 2, 40 and 41 have been rejected under 35 U.S.C. §103(a) as being obvious over Donner in view of Eder. Claims 119, 120, 122 and 123 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 6,356,909 to Spencer in view of U.S. Pat. No. 6,556,992 Barney et al. The

rejection of claims 1-70 and 119-123 are hereby appealed.

IV. Status of Amendments.

The claims have not been amended since the final Office Action of July 31, 2006.

V. Summary of Claimed Subject Matter.

Claim 1 is limited to "A programmed computer." FIG. 1 of the specification shows a computer system and page 12, lines 1-5 discusses the programs within the computer for implementing the system. Appendix I of the specification provides a detailed functional specification of the claimed invention. A detailed functional specification is the standard protocol in the software industry of communicating how a system is to function, and how it is to be used. The detailed functional specification of Appendix I provides a clear, concise and comprehensive description that would enable anyone of skill in the art to make and use the invention. Therefore the specification does disclose adequate structure for these claim elements.

The functionality of the programmed computer is "based upon the six factors of a trade secret from the First Restatement of Torts." The six factors are discussed at page 3, lines 8-15.

The programmed computer is used "for identifying trade

secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets comprises information." The identification of trade secret intellectual property assets is discussed in the Field of the Invention of the specification. A discussion of trade secrets as information is provided in the specification on page 2, lines 7-9. A discussion of search tools to identify and generate a list of trade secrets is discussed in the specification in Appendix I, pages 33-34.

The first element of claim 1 is limited to "means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others." This element is supported by the statement that "As used herein, the step of verifying a status of the trade secret as a protectable interest means applying generally accepted legal criteria (e.g.,

the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts)" (specification, page 23, lines 3-6).

The six factors are shown in Tables A and C of the specification. Table C is a questionnaire with a predetermined criteria for evaluating each of the six factors.

FIG. 1 shows an example of the output device (User Interface Device) and the input device (User Interface Device) of the programmed computer. Page 12, lines 1-5 of the specification discusses the programs within the computer and FIG. 1 shows the Mass Storage Device and Trade Secret Applications that provide the means for displaying the questionnaire. Appendix I, pages 19-23, of the specification provides further details of the software applications within the programmed computer that provides the means for providing the questionnaire of six multiple-choice questions on the output device of a computer.

The second element of claim 1 is limited to "means within the programmed computer for receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors." Support for this claim limitation is shown in FIG. 2 which shows some of the functional elements of the Trade Secret Applications of FIG. 1 and more specifically the software portion of the Trade Secret Applications that accomplishes the entry of trade secret data for each trade secret. Support for the use of the input device is provided in the specification from

page 13, line 28 to page 14, line 2 and Table A. The use of a numerical score is discussed on page 20, lines 14-17 of the specification. Appendix I, page 15, of the specification provides a functional description of the software for inputting of data. Page 19 of Appendix I discusses the functional description of the software of the "means for receiving" in terms of required fields for the six factors that receive the value of a numerical score of from 1 to 5.

The third element of claim 1 is limited to "means within the programmed computer for calculating a metric from the received numerical score values under the six factors." FIG. 12 shows an arithmetic processor. The use of the arithmetic processor for calculating the metric from the received numerical score values under the six factors is discussed starting on page 23, line 1 and continuing to page 24, line 4 of the specification. Appendix I, page 35, of the specification provides a functional description of the means for calculating the metric.

The last element of claim 1 is limited to "means within the programmed computer for ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric." Support for this claim limitation is found in line 32 of the original Abstract. Support for this claim limitation is also provided by the comparison processor shown in FIG. 12 and the discussion beginning on the last paragraph of page 23 and

continuing through line 26 of page 24 wherein the metrics are compared with a threshold value or values and outlying values of calculations are identified. Appendix I, page 35, of the specification provides a functional description of the means for sorting based upon the metric.

Claim 119 is limited to "A programmed computer." FIG. 1 of the specification shows a computer system and page 12, lines 1-5 discusses the programs which form a portion of the computer system. Appendix I of the specification provides an overall functional description of the software of the programmed computer.

The functionality of the programmed computer is "based upon the six factors of a trade secret from the First Restatement of Torts." The six factors are discussed at page 3, lines 8-15.

The programmed computer is used "for identifying trade secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets comprise information." The identification of trade secret intellectual property assets is discussed in the Field of the Invention of the specification. A discussion of trade secrets as information is provided in the specification on page 2, lines 7-9. A discussion of search tools to identify and generate a list of trade secrets is discussed in the specification in Appendix I, pages 33-34.

The first element of claim 119 is limited to the step of "the programmed computer providing a predetermined criteria for

evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others." This element is supported by the statement that "As used herein, the step of verifying a status of the trade secret as a protectable interest means applying generally accepted legal criteria (e.g., the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts)" (specification, page 23, lines 3-6).

The six factors are shown in Tables A and C of the specification. Table C is a questionnaire with a predetermined criteria for evaluating each of the six factors.

FIG. 1 shows an example of the output device (User Interface Device) and the input device (User Interface Device) of the programmed computer. Page 12, lines 1-5 of the specification discusses the programs within the computer and FIG. 1 shows the Mass Storage Device and Trade Secret Applications that allow the



programmed computer to display the questionnaire. Appendix I provides further details of the software applications within the programmed computer that provide the questionnaire of six multiple-choice questions on the output device of a computer.

The second element of claim 119 is limited to "the programmed computer receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors." Support for this claim limitation is shown in FIG. 2 which shows some of the functional elements of the Trade Secret Applications of FIG. 1 and more specifically the software portion of the Trade Secret Applications that allows the programmed computer to accomplish method step of entry of trade secret data for each trade secret. Support for the use of the input device to accomplish the method step is provided in the specification from page 13, line 28 to page 14, line 2 and Table A. Appendix I, pages 12-15, of the specification provides a functional description of the input.

The use of a numerical score is discussed on page 20, lines 14-17 of the specification. Appendix I, page 19, of the specification provides a functional description of the numerical score.

The third step of claim 119 is limited to "the programmed computer calculating a metric from the received numerical score values under the six factors." FIG. 12 shows an arithmetic processor of the programmed computer that accomplishes this step.

The use of the arithmetic processor for calculating the metric from the received numerical score values under the six factors is discussed starting on page 23, line 1 and continuing to page 24, line 4 of the specification. Appendix I, page 35, of the specification provides a functional description of the software for calculating the metric.

The last step of claim 119 is limited to "the programmed computer determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value." Support for this claim limitation is found beginning on line 1 of page 23 and continuing to line 9 of page 24 of the specification wherein the metrics are compared with a threshold value or values to determine if a trade secret is defensible. Appendix I, page 35, of the specification provides a functional description of the software that searches for trade secrets with a "weighted priority greater than specified value."

Claim 120 is limited to "A programmed computer." FIG. 1 of the specification shows a computer system and page 12, lines 1-5 discusses the programs programming the computer.

The functionality of the programmed computer is "based upon the six factors of a trade secret from the First Restatement of Torts." The six factors are discussed at page 3, lines 8-15.

The programmed computer is used "for identifying trade secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets

comprise information." The identification of trade secret intellectual property assets is discussed in the Field of the Invention of the specification. A discussion of trade secrets as information is provided in the specification on page 2, lines 7-9. A discussion of search tools to identify and generate a list of trade secrets is discussed in the specification in Appendix I, pages 33-34.

The first element of claim 120 is limited to the step of "the programmed computer providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others." This element is supported by the statement that "As used herein, the step of verifying a status of the trade secret as a protectable interest means applying generally accepted legal criteria (e.g., the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts)" (specification, page 23, lines 3-

6).

The six factors are shown in Tables A and C of the specification. Table C is a questionnaire with a predetermined criteria for evaluating each of the six factors.

FIG. 1 shows an example of the output device (User Interface Device) and the input device (User Interface Device) of the programmed computer. Page 12, lines 1-5 of the specification discusses the programs within the computer and FIG. 1 shows the Mass Storage Device and Trade Secret Applications that allow the programmed computer to display the questionnaire. Appendix I provides further details of the software applications within the programmed computer that provide the questionnaire of six multiple-choice questions on the output device of a computer.

The second element of claim 120 is limited to "the programmed computer receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors." Support for this claim limitation is shown in FIG. 2 which shows some of the functional elements of the Trade Secret Applications of FIG. 1 and more specifically the software portion of the Trade Secret Applications that allows the programmed computer to accomplish method step of entry of trade secret data for each trade secret. Support for the use of the input device to accomplish the method step is provided in the specification from page 13, line 28 to page 14, line 2 and Table A. Appendix I, pages 12-15, of the specification provides a functional description of an

input portion of the software that receives the numerical score values.

The use of a numerical score is discussed on page 20, lines 14-17 of the specification. Appendix I, page 19, of the specification provides a functional description of a portion of the software that provides the numerical scores.

The third step of claim 120 is limited to "the programmed computer calculating a metric from the received numerical score values under the six factors." FIG. 12 shows an arithmetic processor of the programmed computer that accomplishes this step. The use of the arithmetic processor for calculating the metric from the received numerical score values under the six factors is discussed starting on page 23, line 1 and continuing to page 24, line 4 of the specification. Appendix I, page 35, of the specification provides a functional description of a portion of the software within the programmed computer that calculates the metric.

The last element of claim 120 is limited to "the programmed computer ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric." Support for this claim limitation is found in line 32 of the original Abstract. Support for this claim limitation is also provided by the discussion beginning on the last paragraph of page 23 and continuing line 26 of page 24 wherein the metrics are compared with a threshold value or values and outlying values of calculations are

identified. Appendix I, page 35, of the specification provides a functional description of a portion of the software that sorts based upon the metric.

Claim 121 is limited to "A programmed computer." FIG. 1 of the specification shows a computer system and page 12, lines 1-5 discusses the programs within the computer for implementing the system.

The functionality of the programmed computer is "based upon the six factors of a trade secret from the First Restatement of Torts." The six factors are discussed at page 3, lines 8-15.

The programmed computer is used "for identifying trade secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets comprises information." The identification of trade secret intellectual property assets is discussed in the Field of the Invention of the specification. A discussion of trade secrets as information is provided in the specification on page 2, lines 7-9. A discussion of search tools to identify and generate a list of trade secrets is discussed in the specification in Appendix I, pages 33-34.

The first element of claim 121 is limited to "means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors

including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others." This element is supported by the statement that "As used herein, the step of verifying a status of the trade secret as a protectable interest means applying generally accepted legal criteria (e.g., the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts)" (specification, page 23, lines 3-6).

The six factors are shown in Tables A and C of the specification. Table C is a questionnaire with a predetermined criteria for evaluating each of the six factors.

FIG. 1 shows an example of the output device (User Interface Device) and the input device (User Interface Device) of the programmed computer. Page 12, lines 1-5 of the specification discusses the programs within the computer and FIG. 1 shows the Mass Storage Device and Trade Secret Applications that provide the means for displaying the questionnaire. Appendix I provides further details of the software applications within the programmed computer that provides the means for providing the questionnaire of

six multiple-choice questions on the output device of a computer.

The second element of claim 121 is limited to "means within the programmed computer for receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors." Support for this claim limitation is shown in FIG. 2 which shows some of the functional elements of the Trade Secret Applications of FIG. 1 and more specifically the software portion of the Trade Secret Applications that accomplishes the entry of trade secret data for each trade secret. Support for the use of the input device is provided in the specification from page 13, line 28 to page 14, line 2 and Table A. Appendix I, pages 12-15, of the specification provides a functional description of a portion of the software that receives the numerical score values.

The use of a numerical score is discussed on page 20, lines 14-17 of the specification. Appendix I, page 19, of the specification provides a functional description of a portion of the software that receives the numerical scores.

The third element of claim 121 is limited to "means within the programmed computer for calculating a metric from the received numerical score values under the six factors." FIG. 12 shows an arithmetic processor. The use of the arithmetic processor for calculating the metric from the received numerical score values under the six factors is discussed starting on page 23, line 1 and continuing to page 24, line 4 of the specification. Appendix I,



page 35, of the specification provides a functional description of a portion of the software of the programmed computer that calculates the metric.

The last element of claim 121 is limited to "means within the programmed computer for determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value." Support for this claim element is provided by the arithmetic processor shown in FIG. 12. Support for this claim limitation is found beginning on line 1 of page 23 and continuing to line 9 of page 24 of the specification wherein the metrics are compared with a threshold value or values within the arithmetic processor to determine if a trade secret is defensible. Appendix I, page 35, of the specification provides a functional description of the software that searches for trade secrets with a "weighted priority greater than specified value."

Claim 122 is limited to "A method based upon the six factors of a trade secret from the First Restatement of Torts for providing documentation, analysis, auditing, accounting, protection, and other management relating to an existence, ownership, access and employee notice of a plurality of the trade secrets of an organization." The six factors are discussed at page 3, lines 8-15. The context is discussed within the specification at page 1, lines 5-13; page 3, lines 5-7; page 5, line 3; and page 7, lines 23-30.

The first element of claim 122 is limited to "accepting

six inputs as to the extent that a trade secret meets each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business guard the secrecy of the information; (4) the value of the information to the business and to its competitors; (5) the amount of effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others." FIG. 2 shows the entry of trade secret data for each trade secret. Support for the entry of inputs is provided in the specification beginning on page 13, line 28 and continuing to page 14, line 2 and Table A. An example of the extent to which a trade secret meets each of the six factors is shown in Table C. Appendix I, pages 12-15, of the specification provides a functional description of a portion of the software that accepts data entry.

The second element of claim 122 is limited to "providing a corresponding numerical score value to each of the six inputs." The paragraph of the specification bridging pages 6-7 discusses the provided numerical score value. Table C of the specification provides an example of how the numerical scores could be apportioned. Appendix I, page 19, of the specification provides a functional description of a portion of the software that provides the numerical score values.

The third element of claim 122 is limited to "calculating a single metric for the trade secret from the six numerical scores using logical and mathematical processes." A discussion of the calculation of one or more metrics from the six numerical scores may be found beginning on page 23, line 1 and continuing to line 17 of page 24. Appendix I, page 35, of the specification provides a functional description of the calculation of the metric.

The fourth element of claim 122 is limited to "repeating steps a, b, and c for each remaining trade secret of the plurality of trade secrets." The fourth step is shown in FIG. 2 wherein the process of FIG. 2 is repeated after an application number is assigned or even if a valid trade secret is not found.

The last element of claim 122 is limited to "ranking the plurality of trade secrets in ascending order or descending order of the calculated metric." The ranking of trade secrets is supported in line 32 of the original Abstract. The ranking in ascending or descending order based upon the calculated metric is supported by the identification of outlying values (specification, page 24, lines 18-26). The ranking in ascending or descending order is also supported by the comparison on metrics with threshold values (specification, page 6, line 24). Appendix I, page 35, of the specification provides a functional description of a portion of the software that sorts based upon the calculated metric.

Claim 123 is limited to "A method based upon the six factors of a trade secret from the First Restatement of Torts for

providing documentation, analysis, auditing, accounting, protection, and other management relating to an existence, ownership, access and employee notice of a plurality of the trade secrets of an organization." The six factors are discussed at page 3, lines 8-15. The context is discussed within the specification at page 1, lines 5-13; page 3, lines 5-7; page 5, line 3; and page 7, lines 23-30.

The first element of claim 123 is limited to "accepting six inputs as to the extent that a trade secret meets each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business guard the secrecy of the information; (4) the value of the information to the business and to its competitors; (5) the amount of effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others." FIG. 2 shows the entry of trade secret data for each trade secret. Support for the entry of inputs is provided in the specification beginning on page 13, line 28 and continuing to page 14, line 2 and Table A. An example of the extent to which a trade secret meets each of the six factors is shown in Table C. Appendix I, pages 12-15, of the specification provides a functional description of a portion of the software that accepts data entry.

The second element of claim 123 is limited to "providing a corresponding numerical score value to each of the six inputs." The paragraph of the specification bridging pages 6-7 discusses the provided numerical score value. Table C of the specification provides an example of how the numerical scores could be apportioned. Appendix I, page 19, of the specification provides a functional description of a portion of the software that provides the corresponding numerical score values.

The third element of claim 123 is limited to "calculating a single metric for the trade secret from the six numerical scores using logical and mathematical processes." A discussion of the calculation of one or more metrics from the six numerical scores may be found beginning on page 23, line 1 and continuing to line 17 of page 24 of the specification. Appendix I, page 35, of the specification provides a functional description of a portion of the software that calculates the metric.

The last element of claim 123 is limited to "comparing the calculated metric to a threshold value." Support for this claim element may be found beginning on page 23, line 1 and continuing to line 9 of page 24 of the specification. Appendix I, page 35, of the specification provides a functional description of the software that searches for trade secrets with a "weighted priority greater than specified value."

VI. Grounds of Rejection to be Reviewed on Appeal.

Whether claims 1-70 and 119-123 are enabling under 35 U.S.C. §112, first paragraph. Whether claims 1-70 and 119-123 produce a useful, concrete and tangible result under 35 U.S.C. §112, first paragraph. Whether claims 1-70 and 119-123 are supported by a specific utility under 35 U.S.C. §112, first paragraph. Whether claims 1-70 and 119-123 are statutory under 35 U.S.C. §101. Whether claims 1, 3-35, 37-39, 43, 44, 47-57, 60-63, 67-70 and 121 are anticipated under 35 U.S.C. §102(e) by U.S. Pat. No. 6,263,314 to Donner. Whether claims 1-41, 43, 44, 47-57, 60-63, 67-70 and 121 are anticipated under 35 U.S.C. §102(e) by U.S. Pat. No. 6,393,406 to Eder. Whether claims 42, 45, 46, 58, 59 and 64-66 are rendered obvious under 35 U.S.C. §103(a) by over Donner and Eder in view of U.S. Pat. No. 5,136,646 to Haber. Whether claims 2, 40 and 41 are rendered obvious under 35 U.S.C. §103(a) by Donner in view of Eder. Whether claims 119, 120, 122 and 123 are rendered obvious under 35 U.S.C. §103(a) by U.S. Pat. No. 6,356,909 to Spencer in view of U.S. Pat. No. 6,556,992 Barney et al.

## VII. Argument.

### A. Rejections under 35 U.S.C. §112 for Enablement.

Claims 1-70 and 119-123 have been rejected as failing to comply with the enablement requirements. In particular, the Examiner asserts, with respect to claim 1 that "The applicant's specification does not disclose adequate structure for performing the recited function . . . For example . . . means within the

programmed computer for providing a predetermined criteria" (Office Action of 7/31/06, page 2). However, FIG. 1 clearly shows a computer system, the specification explicitly states that "FIG. 1 is a generalized block diagram illustrating the structure of a specific computer system for implementing the invention" (specification, page 10, lines 14-15) and Table C shows the structure of a predetermined criteria that would be located within the computer of FIG. 1. Therefore the specification discloses adequate structure for this claim element.

The Examiner asserts "The applicant's specification does not disclose adequate structure for performing the recited function . . . For example . . . means for characterizing (whether the trade secret constitutes negative know-how, whether the trade secret is a combinational trade secret)" (Office Action of 7/31/06, page 2). However, page 17, second full paragraph of the specification clearly describes data for identifying whether the trade secret constitutes negative know-how or a combinational trade secret. Therefore the specification discloses adequate structure for this claim element.

The Examiner asserts "The applicant's specification does not disclose adequate structure for performing the recited function . . . For example . . . means for specifying security measures, means for associating said security measures with a trade secret, means for specifying, means for determining which security measures are needed, means for specifying security threats, means for analyzing the ratio . . . means for characterizing security risk"

(Office Action of 7/31/06, page 2). However, the specification, page 17 third full paragraph to page 20, end of the first full paragraph clearly discusses these elements. FIGs. 3 and 4, while being referenced as a flow chart also depict information flow among the software modules that accomplish these functions. Therefore the specification does disclose adequate structure for these claim elements.

The Examiner asserts that "The applicant's specification does not disclose adequate structure for performing the recited function . . . For example . . . means for specifying values for the six factors of a trade secret" (Office Action of 7/31/06, page 2). However, the questionnaire of Table C displayed on the User Interface Device of FIG. 1 clearly provides a means for specifying values.

The Examiner asserts that "The applicant's specification does not disclose adequate structure for performing the recited function . . . For example . . . means for determining employee exposure to a trade secret" (Office Action of 7/31/06, page 2). However, the specification, page 25 first full paragraph to page 28, end of the first full paragraph clearly discusses these elements. The flow chart of FIG. 5 depicts information flow among software modules that accomplish these functions.

The Examiner asserts that "Applicant's specification provides no teaching or disclosure for a means within the programmed computer to provide the predetermined criteria and receive a



numerical score, or rank the potential trade secrets" (Office Action of 7/31/06, page 3). However, Table C provides the predetermined criteria. The questionnaire of Table C and answers to the questions of Table C would be provided through the User Interface Device. The Mass Storage Device of FIG. 1 and associated software provide the means for displaying and receiving. The comparison and/or arithmetic processor and associated software provide a means for ranking.

Moreover, Appendix I of the specification provides a detailed functional specification of the claimed invention. A detailed functional specification is the standard protocol in the software industry of communicating how a system is to function, and how it is to be used. The detailed functional specification of Appendix I is believed to provide a clear, concise and comprehensive description that would enable anyone of skill in the art to make and use the invention. Therefore the specification does disclose adequate structure for these claim elements.

Accordingly, claims 1-70 and 119-123 are enabled. Since claims 1-70 and 119-123 are enabled, the rejections are improper and should be overturned.

The Examiner has rejected claims 119, 120, 122 and 123, but provides no support for such rejection: all of the Examiner's arguments with respect to these claims are directed to "means plus function" elements. Claims 119-123 are method claims that contain no "means" elements. Accordingly, rejection of claims 119, 120, 122

and 123 is inapposite and should be reversed.

B. Rejections under 35 U.S.C. §112 for Enablement.

Claims 1-70 and 119-123 have been rejected as failing to comply with the enablement requirements. The Examiner asserts that "in many of the claims, the means for doing the step is a human being, outside the computer." However, the Examiner's assertion is simply based upon conjecture. Further, the claimed invention is explicitly limited to a programmed computer.

The Examiner again raises issues of "what is the means of indexing trade secrets, means for characterizing, means for specifying security measures, means for determining which security measures are needed, means for specifying security threats" (Office Action of 7/31/06, page 4). With regard to the means for indexing, an indexing processor is shown in FIG. 12 and is described on page 16, last 5 lines. Appendix I, page 16, of the specification provides a functional description of a portion of the associated software that indexes trade secrets.

The "means for characterizing" is set forth in many different parts of the specification. One means for characterizing is set forth in Table C and the software described in Appendix I of the specification that would display the information of any particular questionnaire and that would receive answers. Other "means for characterizing" are shown in FIG. 5 where the method step and (software module for accomplishing that step) are shown.

One "means for specifying security measures" is set forth

in Table C. A "means for determining which security measures are needed" is supported by the "Security Measures Checklist" shown on page 16. A "means for specifying security threats" is supported by the "Security Threats Checklist" shown on page 16.

The Examiner asserts that "The specification does not set forth explicit ranges or explicit criteria for the scores to allow one of skill in the art to make or use the invention without undue experimentation" (Office Action of 7/31/06, page 7). However, as noted above, one example of the criteria is set forth in Table C and the range of 1-5 is also set forth, therefore one of skill in the art can practice the invention without undue experimentation.

The Examiner asserts "that there is a lack of concreteness in applicant's invention due to the inability of the invention to produce reproducible results" (Office Action of 7/31/06, page 8). However, the claimed invention, in every case, is limited to the six factors of a trade secret. The six factors are very specific, as is the criteria set forth in Table C and elsewhere.

Further, the metric calculated from the six factors may be based upon the sixth root. Again, the sixth root is a very specific quantity.

In addition, the specification clearly indicates that the invention is to be practiced within a computer. As such, for any give input to the computer, the results would be completely reproducible.

In general, Examiner's arguments with respect to enablement fails on several levels. On a first level, the selection of a user input is not part of the claimed method or apparatus. The essence of the independent claims is a method or apparatus that aggregates user judgment with respect to six necessary component variables for a trade secret into a single variable, condensing the user's judgment into one variable that can be more easily compared, sorted on, and characterized. For a given input to the method, the output of the method is useful, deterministic, and therefore concrete.

On yet another level, Examiner overstates the subjectivity of the input information. A great deal of research and experience has shown that individuals have little trouble ranking items on a scale of one to five.

Teachers throughout the United States rate students on a scale of one to five: A, B, C, D, and F. These grades are typically aggregated by a weighted arithmetic mean to a GPA, or Grade Point Average. Examiner's argument would indicate that the GPAs of all students in the United States are subjective and not concrete.

Similarly, surveys routinely ask respondents to answer questions on a scale of one to five, such as "Strongly Agree", "Agree", "No Opinion", "Disagree", and "Strongly Disagree", or "Very Low", "Low", "Medium", "High", "Very High". Such surveys are

routinely used to design and modify products throughout the economy, and as a guide to formulate and direct public policy within local, state and federal governments.

In general, and as noted above, the determination of the answers to the six questions is not part of the claimed invention. Even if it were, the answers to the six question do not present an enablement question since techniques for the resolution of inexact questions are well known in the art of surveys and public policy.

The claimed invention is limited to the process of ranking trade secrets based upon grading of the six factors of a trade secret. Since the grading by the user of each of the six factors is outside of the claimed invention, the rejection is inapposite and should be overturned.

Accordingly, claims 1-70 and 119-123 are enabled. Since claims 1-70 and 119-123 are enabled, the rejections are improper and should be overturned.

The Examiner has rejected claims 119, 120, 122 and 123, but provides no support for such rejection: all of the Examiner's arguments with respect to these claims are directed to "means plus function" elements. Claims 119-123 are method claims that contain no "means" elements. Accordingly, rejection of claims 119, 120, 122 and 123 is inapposite and should be reversed.

C. Rejections under 35 U.S.C. §112 for Enablement.

Claims 1-70 and 119-121 have been rejected under 35

U.S.C. §112, first paragraph, as not being supported by a specific or well known utility. However, a specific utility of the independent claims is, in fact, provided in claim 1, element d; in claim 119, element d; claim 120, element d; claim 121, element d; claim 122, element e and claim 123, element d. In particular, the numerical score is used for "ranking the potential trade secret with regard to another potential trade secret . . . based upon the calculated metric" or "determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value" or "ranking the plurality of trade secrets in ascending order or descending order of the calculated metric" or "comparing the calculated metric to a threshold value."

In ranking items or determining the existence of a trade secret based upon a metric or comparing the calculated metric with a threshold, a precise definition (or means of measuring the units to be used) is not required to perform the ranking or determination or comparison. One need not know the length of a furlong in order to know that a horse that won a race by one furlong, in fact, won a much narrower victory than another horse that won a race by three furlongs, thereby comparing the ease with which the horses won their respective victories. Similarly, a device that ranks items or determines or compares (say in some unit of length called a "tang") will obtain results based upon how many tangs long each item is. The result (e.g., item A is longer than item B, item B is longer than item C) has meaning and utility to the user whether the

user knows what the length of a tang is, or even whether the creator of the device has defined (or not defined) the meaning of a "tang" for the user or not.

Similarly, it is the ranking, determination or comparison which is the final result of the independent claims 1-70 and 119-123 and not the numerical score that is calculated as an intermediate claim step.

The Examiner has erred in finding a lack of a specific asserted utility in claims 1-70 and 119-121, because (she has found that) "There is no defined meaning to the score." The score is not the result of the claimed invention. The result of the claimed invention is a ranking, determination or comparison of a metric of a plurality of trade secrets. Based upon the specification, one skilled in the art would clearly know how to use such a metric to obtain the claimed, useful result, which is an aggregation of the evaluator's judgment on the six factors applying to the legal existence of each trade secret in a trade secret portfolio.

The Examiner also states that, "The applicant has not defined the numerical score. There is no defined meaning to the score." The numerical score is defined in claims 1-70 and 119-123 and may be the geometric mean of the values assigned to the six factors in the preceding elements of the claims. This is a precise mathematical definition of the numerical score.

The Examiner also states that, "It is unclear how the numerical score value would be used by a person in the industry."

The claims do not make any assertion of the utility of the numerical score. The output of the invention in claims 1-70 and 119-123 is a ranking of the trade secrets or determination that a potential trade secret is a trade secret or comparison of the calculated metric with a predetermined threshold. One skilled in the art would clearly know how to use such a result, which is an aggregation of the evaluator's judgment on the six factors applied to gauge the legal existence of each trade secret in a trade secret portfolio.

The Examiner's argument in this case appears to be centered around utility, which is not a §112 matter, but a §101 matter. Examiner's argument here for rejection under 35 USC §112 is improper and should be overturned.

The Examiner has rejected claims 119, 120 and 121, but provides no support for such rejection: all of the Examiner's arguments with respect to these claims are directed to "means plus function" elements. Claims 119, 120, 122 and 123 are method claims that contain no "means" elements. Accordingly, rejection of claims 119, 120, 122 and 123 is inapposite and should be overturned.

D) Rejections under 35 U.S.C. §101.

The Examiner has rejected claims 1-70 and 119-123 under 35 USC §101 for failing to produce a useful, concrete, and tangible result. In particular, Examiner asserts that the invention fails to produce a concrete result, and is not supported by either a



credible asserted utility or a well established utility.

Some discussion of "those skilled in the art" is necessary to frame the discussion. The invention is a new method and device for the evaluation of trade secrets. Thus, those skilled in the art would include those already experienced in the evaluation of trade secrets by other means, including judges, intellectual property attorneys, and intellectual asset management professionals. Those skilled in the art in the context of this invention would not include anyone who is not already well-versed (i.e., skilled) in the evaluation of trade secrets.

An applicable analogy here is to a new type of saddle for horse riding. Surely, "those skilled in the art" in this case would apply to people who already know how to ride a horse with other types of saddles, otherwise the use of a new type of saddle would require "undue experimentation". Clearly, those skilled in the art would not include anyone who is not already accomplished in the riding of a horse.

Judges are instructed by §757 of The Restatement (First) of Torts to consider the six factors of a trade secret in adjudicating trade secret disputes, and have been doing so for over sixty years since its publication in 1939. Every trade secrets case includes an analysis by the judge of the extent to which the alleged trade secrets meet the six factors. Attorneys involved in these cases must also perform such analyses in preparing for and trying these cases, knowing that the judge will perform such an

evaluation at trial. There is a great deal of precedent and experiential background for such analyses.

Those skilled in the art have no difficulty in determining whether a trade secret meets each of the six factors on a non-numeric basis. Determinations of whether a trade secret meets one of the six factors is easily characterized by one of such skill in terms of, for example, "Very Low", "Low", "Medium", "High", "Very High". Anyone who cannot reliably make such determination should probably not be trying trade secrets cases, either as judge or counsel, and cannot be considered one skilled in the art of evaluating trade secrets.

What is new in the present invention is to apply a numeric value to these determinations, to calculate a metric therefrom, and to sort or determine the existence of trade secrets based on this metric. The resulting ranking or determination or comparison, it is believed, provides insight into the relative merits of the trade secrets in the listing and the extent to which they meet the legal test. There is a high degree of correlation between the resulting ranking, determination or comparison and the considered judgment of experienced trade secret attorneys in evaluating the extent to which, overall, the trade secrets meet the legal test.

Of course, some differences in the evaluations of individual skilled evaluators will always be present in any judgment. Nevertheless, impartial evaluations show a remarkable

degree of consistency. As in the case of purely objective measurements, there is some degree of error in the specification of any numerical quantity, but such measurement errors do not render the measurements valueless.

There are several examples of similar situations with which everyone is familiar. Movie ratings by experienced film critics are often delivered on a five point - or five star - scale, and ratings for movies are remarkably consistent across different reviewers. Similarly, student essay papers (as opposed to numeric or multiple-choice exams) are typically graded on a five-point scale (A, B, C, D, and F) by skilled professional teachers, and the grades of individual students in writing and other classes requiring essay answers are remarkably consistent across multiple teachers and in different courses.

The question is, in the current case, are the professional judgments of skilled judges, attorneys, and other trade secret professionals so subjective as to render the invention useless.

In particular, Examiner argues in support of the assertion of non-statutory subject matter that "because the answers are subjective for a single situation, there could be different results based on the subjective determination of the user" and that "Therefore, the applicant's invention is not capable of providing concrete results."

In addition to the preceding argument relative to the

evaluative skills specific to the present context of those skilled in the art, it should be repeated that the method of coming to the evaluative judgment on each of the six factors is not a part of the claimed invention. In other words, a different method, device, invention or mental process may be used to arrive at a non-numeric quantitative evaluation (not much, a little, middling, a lot, a 'home run') with regard to each of the six factors, and would still be outside the scope of the claimed invention. The claimed invention is silent on the method used, and many methods could be employed.

Once these judgments are made, they enter the scope of the claimed invention: assigning numerical values, calculating the metric, and ranking, determining or comparing the result. These results are concrete and reproducible, in that a given set of evaluations, that are performed outside the scope of the invention, will always produce exactly the same answer once processed through the steps and apparatus of the claimed invention.

Examiner's argument relies upon inclusion of the evaluative process on each of the six factors (which is not claimed and lies outside of the scope of the invention) as part of the claimed invention in order to come to a conclusion that the invention does not provide a concrete result. Examiner's rejection of the claims under 35 USC § 101 with this argument is therefore improper and should be overruled.

Continuing with the issue of non-statutory subject

matter, Examiner asserts that, "the claimed invention is not supported by either a credible asserted utility or a well established utility. It is unclear how the specific utility of the claimed invention as described in the disclosure of this invention would be useful or tangible to one in the industry."

The disclosure and the claims could not be more clear. The invention allows a skilled evaluator to aggregate his judgments on six independent factors for each of a portfolio of trade secrets into a list of trade secrets sorted in terms of a single value for each trade secret that incorporates his six judgments. The tangible output is a sorted list that reflects the judgments he provided as input to the invention.

The Examiner questions the usefulness of this list to "one in the industry". The Examiner has underestimated the skill of the intellectual property bar and bench in the evaluation of trade secrets using parameters that have been well-established law for over six decades in order to come to the conclusion that this list has no usefulness due to the "subjective determination of the user". These evaluations in practice do not have such variability as to render such a list useless to another user.

Further, the relatively small variability in these evaluations are inversely proportional to the skill of the user. As has been previously noted, movie ratings are remarkably uniform in a much more subjective area (i.e., the evaluation of art). Nevertheless, movie ratings are widely published and used by

moviegoers. As with movie ratings, evaluations of trade secrets reflect the skill of the evaluator, and the extent to which a particular evaluation will be considered accurate will depend somewhat on the reputation of the reviewer ("How many stars did Roger Ebert give this movie?") but to a lesser extent due to the more well-documented criteria for trade secrets, based on sixty years of experience and court findings. The usefulness of the list will be somewhat dependent on the relative skills of evaluators, but, for evaluators considered skilled in the art, the usefulness of the list will never be zero.

Finally, while Examiner has questioned the usefulness of the produced ranking to a person in the industry, there is no question that the listing is useful to the evaluator himself. It is, after all, a sorted list of his own aggregated judgment. To the extent that the six evaluations for each trade secret are subjective, they are his subjective evaluations. The list thus condenses six independent evaluations for each trade secret of a large portfolio of trade secrets into a single sorted list reflecting his own judgment. Surely it stretches imagination to believe that this evaluator will not find his own list so produced to be useful to himself.

While it is believed that the ranking or determination of the existence of trade secrets that is the tangible output of the invention does in fact have usefulness to another skilled in the art, dependent on the skill in the art of the original evaluator,

such usefulness is not required to meet the usefulness test of 35 USC §101. Usefulness to the original evaluator himself is sufficient. Examiner's rejection of the claims under 35 USC § 101 with this argument is therefore improper and should be overruled.

With regard to claims 8-31, 49-56 and 69, the Examiner asserts that "The means for performing the function of the above referenced claims appears to be a human being" (Office Action of 7/31/06, page 13). However, the claims are explicitly directed to a programmed computer. Accordingly, the Examiner's assertion is misplaced and contrary to the express limitations of the claims and rejection on these grounds should be overturned.

The user's understanding of the numerical score, or lack thereof, does not impact the usefulness of the invention under any of the claims. Examiner's rejection of the other claims under 35 USC § 101 with this argument is therefore improper.

Accordingly, claims 1-70 and 119-123 are directed to statutory subject matter. Since the claims are directed to statutory subject matter, the rejections are improper and should be overturned.

E) Rejections under 35 U.S.C. §101.

The Examiner has rejected claims 8-31, 49-56 and 69 under 35 U.S.C. §101 and MPEP §2105 based upon the assertion that "the above referenced claims appears to be a human being" (Office Action of 7/31/06, page 13). However, claims 8-31, 49-56 and 69 are all

dependent upon claim 1 and therefore incorporate the limitations of claim 1. Claim 1 is clearly limited to a programmed computer. Since claim 1 is limited to a programmed computer, then so too are claims 8-31, 49-56 and 69. Accordingly, the Examiner's assertion is misplaced and contrary to the express limitations of the claims. Since the Examiner's assertions are misplaced and contrary to the claims, the rejections are improper and should be overturned.

F) Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 121 have been rejected as being anticipated by Donner. The Examiner cites In re Schreiber as a basis for rejecting the claims under Donner. However, the board in Schreiber found that the structure of Harz was inherently capable of dispensing popcorn and, therefore was an effective reference against Schreiber. In contrast, the structure of Donner is not inherently capable of aggregating user judgments related to trade secrets into a ranked listing because it does not disclose a questionnaire based on the six factors of a trade secret.

The Examiner's argument is clearly based upon ignoring the claim limitations requiring that the questionnaire be directed to the six factors of a trade secret. As clearly demonstrated by the case law and the specification, the claimed questionnaire is structurally related to the creation of a ranked listing of trade secrets.

Since Donner is not inherently capable of aggregating user



judgments related to trade secrets and does not provide any means for ranking potential trade secrets, Donner does not do the same or any similar thing in exactly the same way as that of the claimed invention. Since Donner does not do the same or any similar thing as that of the claimed invention, the rejections are improper and should be overturned.

G) Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 121 have been rejected under 35 U.S.C. §102(e) as being anticipated by Eder. The Examiner again cites In re Schreiber as a basis for rejecting the claims under Eder. The board in rejecting Schreiber found that the structure of Harz is inherently capable of dispensing popcorn. The structure of Eder is not inherently capable of aggregating user judgments related to trade secrets into a ranked listing because it does not disclose a questionnaire based on the six factors of a trade secret.

The Examiner's argument is clearly based upon ignoring the claim limitations requiring that the questionnaire be directed to the six factors of a trade secret. As clearly demonstrated by the case law and the specification, the claimed questionnaire is structurally related to the creation of a ranked listing of trade secrets.

Since Eder is not inherently capable of aggregating user judgments related to trade secrets and does not provide any means for ranking potential trade secrets, Eder does not do the same or

any similar thing in as that of the claimed invention. Since Eder does not do the same or any similar thing as that of the claimed invention, the rejections are improper and should be overturned.

H) Claims 42, 45-46, 58-59 and 64-66 have been rejected under 35 U.S.C. §103(a) as being obvious over Donner, Eder and U.S. Pat. No. 5,136,646 to Haber et al. However, Haber et al. (as with Donner and Eder) also fails to provide any teaching or suggestion of any apparatus for ranking trade secrets.

More specifically, the combination fails to provide any "means . . . for providing a predetermined criteria for evaluating a potential trade secret . . . under each of the six factors of a trade secret . . . means . . . for receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors . . . means within the programmed computer for calculating a metric from the received numerical score values under the six factors" or "means within the programmed computer for ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric." Since the combination of Donner, Eder and Haber et al. is not inherently capable of aggregating user judgments related to trade secrets or teach or suggest the specifically claimed limitations related to ranking potential trade secrets or using the six factors from the First Restatement of Torts, the combination fails to teach

or suggest each and every claim limitation. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be overturned.

I) Claims 2, 40 and 41 have been rejected under 35 U.S.C. §103(a) as being obvious over Donner and Eder. However, as demonstrated above, Donner and Eder fails to provide any teaching or suggestion of any apparatus for ranking trade secrets. More specifically, the combination fails to provide any "means . . . for providing a predetermined criteria for evaluating a potential trade secret . . . under each of the six factors of a trade secret . . . means . . . for receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors . . . means within the programmed computer for calculating a metric from the received numerical score values under the six factors" or "means within the programmed computer for ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric."

Since the combination of Donner and Eder is not capable of aggregating user judgments related to trade secrets or ranking potential trade secrets or using the six factors from the First Restatement of Torts, the combination fails to teach or suggest each and every claim limitation. Since the combination fails to teach or suggest each and every claim limitation, the rejections

are improper and should be overturned.

J) Claims 119, 120, 122 and 123 have been rejected under 35 U.S.C §103(a) as being obvious over Spencer in view of Barney. In this regard, Spencer is directed to "An integrated web based system for generating electronic request for proposal (RFP) forms and responding to the generated RFPs over a secure communications network" (Spencer, Abstract, lines 1-3). Barney et al. is directed to a METHOD AND SYSTEM FOR RATING PATENTS AND OTHER INTANGIBLE ASSETS" (Barney et al., title).

The Examiner admits that "neither Spencer or Barney explicitly disclose rating trade secrets or the questions relating to the six factors for a trade secret of the First Restatement of Torts or calculating a geometric mean, the sixth root of the product, of the numerical score value" (Office Action of 7/31/06, page 18) but asserts that these features do not differentiate the claimed invention from the prior art.

The Examiner asserts that using the geometric mean would have been a modification of Spencer obvious to one of ordinary skill in the art. Spencer, however, forms his scorecards from a summing, or totaling, of weighted values assigned to questionnaire responses. This is consistent with the typical process of evaluating responses to Requests for Proposal (RFPs) widely practiced manually at the time of Spencer's invention. That is, the summing of weighted scores for RFP responses was widely

practiced at the time and incorporated by Spencer as particularly relevant to the subject matter of scoring responses to RFPs. No other mathematical operation is disclosed or taught by Spencer in the creation of his scorecards than the simple addition of weighted scores.

Barney uses a statistical regression analysis in generating his ranking criteria, and does not disclose the use of the geometric mean in the evaluation of intellectual property. Nor does the combination of Barney and Spencer provide a basis for the geometric mean: according to Examiner, "neither Spencer or Barney explicitly disclose ... calculating a geometric mean."

Examiner's argument that the use of the geometric mean "would have been obvious to one of ordinary skill in the art" is based on the geometric mean being "old and well-known" and defined in on-line references. Examiner makes no argument and cites no prior art that the geometric mean has ever been previously used to generate a ranking criteria for the evaluation of trade secrets or other intellectual property. Examiner's determination that the use of the geometric mean as a modification of Spencer would have been obvious is totally unsupported by citation of any prior art.

In Examiner's argument, any mathematical function that is "old and well-known" and defined in on-line references would be an obvious extension of prior art. What Examiner does not address is why this particular mathematical calculation, out of the tens of thousands of "old and well-known" mathematical functions in various

sources, including the United States Department of Commerce "The Handbook of Mathematical Functions", published since 1964 and now being updated on-line as the Digital Library of Mathematical Functions at [www.dlmf.nist.gov](http://www.dlmf.nist.gov), should be considered obvious in the creation of a ranking criteria for intellectual property.

Why, given the large number of mathematical calculations available, should this calculation be considered an obvious extension of Spencer? How obvious is the selection of a single mathematical calculation out of tens of thousands of possibilities, all of which are "old and well-known", as being peculiarly appropriate for the creation of a ranking criteria for trade secrets? Where is the prior art suggesting any applicability of the geometric mean to intellectual property to support Examiner's assertion?

In fact, the geometric mean is typically used, and considered particularly appropriate, for the averaging of multiple measurements of a single physical quantity, such as the flow of liquid in a tube or blood flow in a blood vessel, to come up with an accurate value. Its use for creating a ranking criteria for trade secrets from multiple different evaluation parameters is in fact counterintuitive based on this prior art.

Examiner has failed to substantiate the claim that the geometric mean is an obvious modification of the prior art. The use of the geometric mean differentiates applicant's invention from the prior art, including Spencer and Barney. Rejection of the

claims as unpatentable under Spencer in light of Barney is therefore improper and should be overruled.

In order to assert the non-obviousness rejection, Examiner must also address the subject matter of trade secrets and the fact that the questionnaire (e.g., Table C of the Specification) relates to the six factors of a trade secret from the First Restatement of Torts, which Examiner has also admitted are not explicitly disclosed by Spencer or Barney. Examiner has determined that these are "non-functional descriptive data" and "are not functionally interrelated with the useful arts, structure or properties of the claimed invention" (Office Action of 7/31/06, page 19). Examiner cites Gulack and Lowry as precedents for this determination, but makes no argument and provides no discussion of these cases beyond the citation.

Both Gulack and Lowry are based on a previous case, *In re Miller* (418 F.2d 1392, 164 USPQ 46) which was an appeal of the rejection of claims drawn to a measuring device for use in fractioning recipes. In *Miller*, the U.S. Court of Customs and Patent Appeals reversed the rejection, which was based on the argument that the indicia and legends did not distinguish the claimed invention from the prior art of a simple measuring cup. The CCPA in particular pointed out that "[i]t seems to us that what is significant here is not structural but *functional* relationship."

The analogy to *Miller* is exact. The *Miller* device presented indicia and legends to the user to provide the user the

information to determine the proper amount of ingredient to use in a fractional recipe. The operation (filling the measuring cup and using it to pour the ingredient) was unchanged over that of a simple measuring cup. The information provided to the user by the legends and indicia directed the use of the measuring cup to achieve the claimed useful result but did not change the manner in which measurement was performed.

The CCPA in Miller found a functional relationship between the indicia and legends and Miller's measuring cup. The U.S. Court of Appeals Federal Circuit in Gulack and the Board of Patent Appeals and Interferences in Lowry reversed both cases based on the functional relationship standard set forth in Miller. The CAFC in Gulack noted (in citing Miller) that "the critical question is whether there exists any new and unobvious functional relationship..."

Applicant asserts that there is a functional relationship between the questionnaire in the independent claims being directed to the six factors of a trade secret (from the First Restatement of Torts) and the useful acts, structure or properties of the claimed invention. In particular, the independent claims each result in the creation of a ranked listing of trade secrets in a trade secret portfolio. The trade secrets are ranked through the use of a numerical value derived from the judgment of the user in responding to a questionnaire about the trade secret. The questionnaire provided to the user directs his responses to six questions that



are the established precedent for a determination by a court of a legally protected status as a trade secret.

The presentation of the questionnaire based on the six factors of a trade secret to the user is thus functionally interrelated to the useful act of creating a listing of trade secrets in the ranked order in which they can be expected to pass legal muster, at least in the aggregated judgment of the user. Absent the questionnaire being related to the six factors of a trade secret from the First Restatement of Torts, but fulfilling all of the other steps disclosed in the prior art, the claimed invention would fail to provide any information whatsoever on the expected legal status of the trade secret, which must be based on the six factors.

The presentation of the questionnaire based on the six factors of a trade secret to the user is also functionally interrelated to the structure of the claimed invention, in that the structure of the claimed invention includes the use of a questionnaire as a first element of each of the independent claims. Examiner acknowledges that the use of a questionnaire is part of the structure of the claimed invention in detailing the use of a questionnaire in Spencer as an element in common with the claimed invention. The questions based on the six factors of a trade secret from the First Restatement of Torts form the substance of the questionnaire, which is part of the structure of the claimed invention. They are thus interrelated.

Examiner's finding that "The fact that ... the questions relate to the First Restatement of Torts is determined to be non-functional descriptive data" is not supported by Miller, Gulack, or Lowry. In all three of these cases, rejections under the non-obviousness criteria based on determinations that portions of claim elements were non-functional descriptive data that did not rise to the level of patentability were overturned. Examiner in each case was overzealous in discarding claim language and was reversed. Similarly in the case at hand, Examiner has discarded clearly functional language from the claim elements.

The clearest language is provided in Gulack to guide these decisions: "What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." In the Gulack case, the content of the printed matter was set aside by the Examiner, as not rising to the level of patentability, rendering Gulack's invention undifferentiated with respect to the prior art of a substrate containing printed matter. The CAFC disagreed, noting the difference between the content of the printed matter in Gulack's invention and the prior art and the manner in which the content was determined.

In the applicant's claims, then, "the critical question is whether there exists any new and unobvious functional relationship between" a questionnaire related to the six factors of a trade secret from the First Restatement of Torts and the process of assigning numerical values, calculating a metric, and ranking trade secrets. That is, does the difference in the content of the questions in the questionnaire, like Gulack's printed matter, differentiate the claimed invention from the prior art. Further, does the difference in the manner in which the content of the questionnaire was determined (by basing it on the formal legal criteria for the subject matter) differentiate the content from the prior art.

In this regard, applicant notes that the six factors were published in the First Restatement of Torts in 1939, and have served as the legal basis for determining legal trade secret status for over sixty years. The six factors have been taught in law schools, argued in courtrooms, and weighed in courtrooms by teachers, attorneys and judges in trade secret law throughout that time. In addition, the economic importance of trade secrets, the theft of trade secrets, and the litigation of trade secret cases have grown in absolute and dollar amounts throughout those six decades. Finally, the emphasis on modern accounting procedures and transparent shareholder reporting has put tremendous pressure on the accountancy profession and the intellectual property bar to produce a method for analyzing the existence of a trade secret.

In all those sixty years, despite the increasing economic need and the mounting pressure for a solution, no law school professor, no intellectual property attorney, no judge, no accountant ever conceived of combining a questionnaire related to the six factors of a trade secret from the First Restatement of Torts and the process of assigning numerical values, calculating a metric, and ranking trade secrets. The claimed invention represents "a new and unobvious functional relationship" between the content of the trade secret questionnaire and the process of assigning numerical values, calculating a metric, and ranking trade secrets.

In general, the Examiner's rejection of the independent claims under the non-obviousness requirement is improper and should be overturned on two grounds: that the geometric mean in the claimed context is not obvious, and that the six factors of a trade secret from the First Restatement of Torts is not non-functional descriptive data. Since the Examiner's rejection of the independent claims under 35 USC § 103(a) is thus improper, it should be overruled.

K)           A Prima facie Case of Obviousness Has Not Been Established

The Federal Circuit has continually held that the Examiner has the burden under 35 U.S.C. §103 of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). This burden may be satisfied only by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to the claimed invention. For example, as the Federal Circuit has held recently, as well as on numerous other occasions: "[t]here must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, supra, 24 USPQ2d at 1446.

Moreover, the mere fact that the prior art references could be modified in the manner proposed by the Examiner would not have made the modification obvious unless there is some motivation or suggestion in the prior art to do so. In re Gordon, 773 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), also see In re Fritch, 972 F.2d 1260, 23 USPQ2d 1781, 1783 (Fed. Cir. 1992) (The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification).

When making an assessment of the obviousness of the claimed invention, the prior art, viewed as a whole, must "suggest the desirability, and thus the obviousness, of making the combination." In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992), quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed.

Cir. 1984). Similarly, the Examiner, under §103, must consider the claimed subject matter "as a whole". In assessing the claimed subject matter "as a whole", the results and advantages of the claimed invention must be considered. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643, 2 USPQ2d 143 (Fed. Cir. 1987).

It is incumbent upon the Examiner to demonstrate that the proposed combination of reference teachings is proper. Where no express teaching or suggestion is apparent from the references, the Examiner must establish, with evidence or reasoning, why one skilled in the art would have been led by the relevant teachings of the applied references to make the proposed combination. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); ACS Hospital System, Inc. v. Montefiorde Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). When making an obviousness rejection, "[i]t is impermissible, however, simply to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template". In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Applicant submits that it does not require a close examination of the record to determine that the Examiner has failed to meet the burden of establishing a prima facie case of obviousness. In general, the Examiner has failed to establish any credible basis why one skilled in the art would have been led by the relevant teachings of the applied references to make the

proposed combination.

None of the cited references are directed to trade secrets. None of the cited references recognize the value of ranking trade secrets. None of the cited references provide any method of aggregating the six factors of a trade secret. None of the cited references even mentions the six factors of a trade secret. As such, the combination of Spencer and Barney et al. clearly fails to provide any teaching or suggestion of any method of ranking trade secrets using the six factors.

For the foregoing reasons, allowance of claims 1-70 and 119-123, as now presented, is believed to be in order. It is respectfully requested that this Board reverse the decision of the Examiner in all respects.

Respectfully submitted,

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VIII. APPENDIX OF THE CLAIMS

1. (Previously Presented) A programmed computer based upon the six factors of a trade secret from the First Restatement of Torts for identifying trade secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets comprises information, said programmed computer comprising:

a) means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others;

b) means within the programmed computer for receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors;

c) means within the programmed computer for calculating a metric from the received numerical score values under the six factors; and

d) means within the programmed computer for ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric.



2. (Previously Presented) The programmed computer of claim 1, further comprising printer means for printing out data, displays, and the results of searches and calculations.

3. (Previously Presented) The programmed computer of claim 1, further comprising system interface means for providing user interface functions, printing functions, or mass data storage functions through the use of another computer system, or for connection to the registration system.

4. (Previously Presented) The programmed computer of claim 1, further comprising means for indexing trade secret drafts.

5. (Previously Presented) The programmed computer of claim 1, further comprising means for indexing trade secret applications.

6. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for indexing trade secret drafts;
- b) means for indexing trade secret applications; and
- c) means for converting trade secret drafts into trade secret applications.

7. (Previously Presented) The programmed computer of claim 1, further comprising means for storing changes to the data to provide audit trail and history of all changes.

8. (Previously Presented) The programmed computer of claim 1, further comprising means for characterizing whether the trade secret constitutes negative know-how.

9. (Previously Presented) The programmed computer of claim 1, further comprising means for characterizing whether the trade secret is a combinational trade secret.

10. (Previously Presented) The programmed computer of claim 1, further comprising means for specifying security measures by company location.

11. (Previously Presented) The programmed computer of claim 10, further comprising means for associating said specified security measures with a trade secret based on one or more company locations associated with a trade secret.

12. (Previously Presented) The programmed computer of claim 1, further comprising means for specifying security measures used to protect a trade secret.

13. (Previously Presented) The programmed computer of claim 12, further comprising means for calculating from said specified security measures a security measures factor for a trade secret.

14. (Previously Presented) The programmed computer of claim 1, further comprising means for specifying security threats to a trade secret.

15. (Previously Presented) The programmed computer of claim 14, further comprising means for calculating from said specified security threats a security threats factor for a trade secret.

16. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying security measures used to protect a trade secret;
- b) means for specifying security threats to a trade secret; and
- c) means for entering and recording which security measures counteract each security threat.

17. (Previously Presented) The programmed computer of claim 16, further comprising means for determining which security measures are needed for each trade secret based on the security threats to each trade secret.

18. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying security measures by company location;
- b) means for specifying security threats to a trade secret;
- c) means for entering and recording which security measures counteract each security threat;
- d) means for determining which security measures are needed for each trade secret based on the security threats to each trade secret; and
- e) means for determining which security measures needed for each trade secret based on the security threats to each trade secret are also available at the company location.

19. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying security measures used to protect a trade secret;
- b) means for calculating from said specified security measures a security measures factor for a trade secret;
- c) means for specifying security threats to a trade secret;
- d) means for calculating from said specified security threats a security threats factor for a trade secret; and
- e) means for calculating from the security measures factor and security threats factor a ratio associated with a trade secret.

20. (Previously Presented) The programmed computer of claim 19, further comprising means for analyzing said ratio to identify outlying values for further inspection.

21. (Previously Presented) The programmed computer of claim 1, further comprising means for specifying values for the six factors of a trade secret enumerated in Section 757 of the First Restatement of Torts.

22. (Previously Presented) The programmed computer of claim 21, further comprising means for calculating various weighted values of the six factors using logical and mathematical equations to generate a single defendability factor associated with a trade secret.

23. (Previously Presented) The programmed computer of claim 22, further comprising means for analyzing said defendability factor to identify outlying values for further inspection.

24. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying security measures used to protect a trade secret;
- b) means for calculating from said specified security measures a security measures factor for a trade secret;
- c) means for specifying values for the six factors of a trade secret enumerated in Section 757 of the First Restatement of Torts;
- d) means for calculating various weighted values of the six factors using logical and mathematical equations to generate a single defendability factor associated with a trade secret; and
- e) means for calculating from the security measures factor and the single defendability factor a ratio associated with a trade secret.

25. (Previously Presented) The programmed computer of claim 24, further comprising means for analyzing said ratio to identify outlying values for further inspection.

26. (Previously Presented) The programmed computer of claim 1, further comprising means for determining employee exposure to a trade secret based on the organization and the date range within which he or she was employed and the organization and the date range within which the trade secret was known within that organization.

27. (Previously Presented) The programmed computer of claim 1, further comprising means for determining employee exposure to a trade secret based on the company location and the date range within which he or she was employed and the company location and the date range within which the trade secret was known within that company location.

28. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for determining employee exposure to a trade secret based on the organization and the date range within which he or she was employed and the organization and the date range within which the trade secret was known within that organization;
- b) means for determining employee exposure to a trade secret based on the company location and the date range within which he or she was employed and the company location and the date range within which the trade secret was known within that company location; and
- c) means for generating a report documenting the employee exposure to a trade secret based on the organization and the company location and the date range within which the trade secret was known within that organization or company location.

29. (Previously Presented) The programmed computer of claim 28, further comprising means for characterizing employee exposure to company trade secrets in one or more employee exposure factors.

30. (Previously Presented) The programmed computer of claim 1, further comprising means for characterizing security risk associated with an employee's position in the company in one or more employee position risk factors.

31. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for determining employee exposure to a trade secret based on the organization and the date range within which he or she was employed by the organization and the date range within which the trade secret was known within that organization;
- b) means for determining employee exposure to a trade secret based on the company location and the date range within which he or she was employed and the company location and the date range within which the trade secret was known within that company location;
- c) means for generating a report documenting the employee exposure to a trade secret based on the organization and the company location and the date range within which the trade secret was known within that organization or company location;
- d) means for characterizing employee exposure to company trade secrets in one or more employee exposure factors;
- e) means for characterizing security risk associated with an employee's position in the company in one or more employee position risk factors; and
- f) means for calculating from one or more employee exposure factors and one or more employee position risk factors an employee risk factor.

32. (Previously Presented) The programmed computer of claim 1, further comprising means for archiving employee confidentiality agreements and the dates on which the employee confidentiality agreements were executed.

33. (Previously Presented) The programmed computer of claim 1, further comprising means for determining a renewal period for employee confidentiality agreements from elements of employee data, employee factors, and employee reports.

34. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for archiving employee confidentiality agreements and the dates on which the employee confidentiality agreements were executed;
- b) means for determining a renewal period for employee confidentiality agreements from elements of employee data, employee factors, and employee reports; and
- c) means for calculating employee confidentiality agreements due for renewal.

35. (Previously Presented) The programmed computer of claim 34, further comprising means for generating for viewing or printing a report listing employee confidentiality agreements due for renewal.

36. (Previously Presented) The programmed computer of claim 34, further comprising means for printing employee confidentiality agreements due for renewal.

37. (Previously Presented) The programmed computer of claim 1, further comprising means for archiving employee confidentiality reminders and the dates on which the employee confidentiality reminders were sent.

38. (Previously Presented) The programmed computer of claim 1, further comprising means for determining a renewal period for employee confidentiality reminders from elements of employee data, employee factors, and employee reports.

39. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for archiving employee confidentiality reminders and the dates on which the employee confidentiality reminders were sent;
- b) means for determining a renewal period for employee confidentiality reminders from elements of employee data, employee factors, and employee reports; and
- c) means for calculating employee confidentiality reminders due for renewal.

40. (Previously Presented) The programmed computer of claim 39, further comprising means for generating for viewing or printing a report listing employee confidentiality reminders due for renewal.

41. (Previously Presented) The programmed computer of claim 39, further comprising means for printing employee confidentiality reminders due for renewal.

42. (Previously Presented) The programmed computer of claim 41, further comprising means for retaining proof-of-receipt documents for hard-copy employee confidentiality reminders.

43. (Previously Presented) The programmed computer of claim 39, further comprising means for emailing employee confidentiality reminders due for renewal directly to the employee.

44. (Previously Presented) The programmed computer of claim 43, further comprising means for retaining proof-of-receipt documents for e-mail employee confidentiality reminders.

45. (Previously Presented) The programmed computer of claim 1, further comprising means for creating a specification of the type



of a trade secret using alphabetic, numeric, or alphanumeric fields to characterize information about the type of trade secret.

46. (Previously Presented) The programmed computer of claim 45, further comprising means for encoding said specification of the type of a trade secret.

47. (Previously Presented) The programmed computer of claim 1, further comprising means for calculating the net present value of a trade secret from an estimated commercial value on a given date and a depreciation or appreciation method.

48. (Previously Presented) The programmed computer of claim 47, further comprising means for characterizing the net present value of a trade secret in a net present value factor.

49. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying security measures used to protect a trade secret;
- b) means for calculating from said specified security measures a security measures factor for a trade secret;
- c) means for calculating the net present value of a trade secret from an estimated commercial value on a given date and a depreciation or appreciation method;
- d) means for characterizing the net present value of a trade secret in a net present value factor; and
- e) means for calculating from the security measures factor and the net present value factor a ratio associated with a trade secret.

50. (Previously Presented) The programmed computer of claim 49, further comprising means for analyzing said ratio to identify outlying values for further inspection.

51. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying values for the six factors of a trade secret enumerated in Section 757 of the First Restatement of Torts;
- b) means for calculating the net present value of a trade secret from an estimated commercial value on a given date and a depreciation or appreciation method;
- c) means for characterizing the net present value of a trade secret in a net present value factor; and
- d) means for calculating from the economic benefit factor and the net present value factor a ratio associated with a trade secret.

52. (Previously Presented) The programmed computer of claim 51, further comprising means for analyzing said ratio to identify outlying values for further inspection.

53. (Previously Presented) The programmed computer of claim 1, further comprising means for specifying source status of a trade secret.

54. (Previously Presented) The programmed computer of claim 1, further comprising means for recording purchase and licensed-from data of a trade secret.

55. (Previously Presented) The programmed computer of claim 1, further comprising means for specifying licensing status of a trade secret.

56. (Previously Presented) The programmed computer of claim 1, further comprising means for recording sale and licensed-to data of a trade secret.

57. (Previously Presented) The programmed computer of claim 1, further comprising means for splitting data associated with selected trade secrets from one database into a separate database.

58. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for indexing trade secret drafts;
- b) means for splitting data associated with selected trade secrets from one database into a separate database; and
- c) means for modifying the alphabetic or alphanumeric sequence of the trade secret draft identifier of selected trade secrets when splitting data associated with said trade secrets into a separate database.

59. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for indexing trade secret applications;
- b) means for splitting data associated with selected trade secrets from one database into a separate database; and
- c) means for modifying the alphabetic or alphanumeric sequence of the trade secret application identifier of selected trade secrets when splitting data associated with said trade secrets into a separate database.

60. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying source status of a trade secret;
- b) means for splitting data associated with selected trade secrets from one database into a separate database; and
- c) means for modifying the source status of selected trade secrets when splitting data associated with said trade secrets into a separate database.

61. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for recording purchase and licensed-from data of a trade secret;
- b) means for splitting data associated with selected trade secrets from one database into a separate database; and
- c) means for modifying the purchase and licensed-from data of selected trade secrets when splitting data associated with said trade secrets into a separate database.

62. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying licensing status of a trade secret;
- b) means for splitting data associated with selected trade secrets from one database into a separate database; and
- c) means for modifying the licensing status of selected trade secrets when splitting data associated with said trade secrets into a separate database.

63. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for recording sale and licensed-to data of a trade secret;
- b) means for splitting data associated with selected trade secrets from one database into a separate database; and
- c) means for modifying the sale and licensed-to data of selected trade secrets when splitting data associated with said trade secrets into a separate database.

64. (Previously Presented) The programmed computer of claim 1, further comprising means for merging data associated with selected trade secrets from two databases into a single database.

65. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for indexing trade secret drafts;
- b) means for merging data associated with selected trade secrets from two databases into a single database; and
- c) means for modifying the alphabetic or alphanumeric sequence of the trade secret draft identifier of selected trade secrets when merging data associated with said trade secrets into a single database.

66. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for indexing trade secret applications;
- b) means for merging data associated with selected trade secrets from two databases into a single database; and
- c) means for modifying the alphabetic or alphanumeric sequence of the trade secret application identifier of selected trade secrets when merging data associated with said trade secrets into a single database.

67. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying source status of a trade secret;
- b) means for merging data associated with selected trade secrets from two databases into a single database; and
- c) means for modifying the source status of selected trade secrets when merging data associated with said trade secrets into a single database.

68. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for recording purchase and licensed-from data of a trade secret;

- b) means for merging data associated with selected trade secrets from two databases into a single database; and
- c) means for modifying the purchase and licensed-from data of selected trade secrets when merging data associated with said trade secrets into a single database.

69. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for specifying licensing status of a trade secret;
- b) means for merging data associated with selected trade secrets from two databases into a single database; and
- c) means for modifying the licensing status of selected trade secrets when merging data associated with said trade secrets into a single database.

70. (Previously Presented) The programmed computer of claim 1, further comprising:

- a) means for recording sale and licensed-to data of a trade secret;
- b) means for merging data associated with selected trade secrets from two databases into a single database; and
- c) means for modifying the sale and licensed-to data of selected trade secrets when merging data associated with said trade secrets into a single database.

71. (Withdrawn) A programmed computer for providing registration and verification of the existence, ownership, contents, and other information relating to a trade secret, said programmed computer comprising:

- a) means within the programmed computer for receiving application fingerprints associated with the trade secret;
- b) means within the programmed computer for calculating a certificate fingerprint from the application fingerprints; and

c) means within the programmed computer for indexing the certificate fingerprint.

72. (Withdrawn) The programmed computer of claim 71, further comprising printer means for printing out data, displays, and the results of searches and calculations.

73. (Withdrawn) The programmed computer of claim 71, further comprising system interface means for providing user interface functions, printing functions, or mass data storage functions through the use of another computer system, or for connection to the accounting system.

74. (Withdrawn) The programmed computer of claim 71, further comprising means for associating more than one application fingerprint with a single trade secret.

75. (Withdrawn) The programmed computer of claim 71, further comprising means for registering more than one application fingerprint with a single trade secret.

76. (Withdrawn) The programmed computer of claim 71, further comprising means for registering an additional application fingerprint with a trade secret previously registered.

77. (Withdrawn) The programmed computer of claim 71, further comprising means for registering an application fingerprint associated with other data in the same registration record database with trade secret registrations.

78. (Withdrawn) The programmed computer of claim 71, further comprising means for maintaining a directory of registration information.

79. (Withdrawn) The programmed computer of claim 78, further comprising means for publishing a directory of registration information.

80. (Withdrawn) The programmed computer of claim 79, further comprising means for publishing a directory of registration information on a limited basis.

81. (Withdrawn) The programmed computer of claims 1 or 71, further comprising means for communicating data between the systems, forming in effect a single system.

82. (Withdrawn) The programmed computer of claim 81, further comprising means for detecting corruption in the trade secret registration database.

83. (Withdrawn) The programmed computer of claim 81, further comprising means for detecting corruption in the trade secret registration database during normal operation.

84. (Withdrawn) The programmed computer of claim 81, further comprising means for locating corruption in the trade secret registration database.

85. (Withdrawn) The programmed computer of claim 71, further comprising means for making contemporaneous backups of transactions performed by the trade secret registration system.

86. (Withdrawn) The programmed computer of claim 71, further comprising means for providing multiple registration records with an additional index number to create a registration that may have multiple entries.

87. (Withdrawn) The programmed computer of claim 86, further



comprising means for creating a registration record without said additional index number to accommodate registrations with single entries in the same registration record database as those with multiple entries.

88. (Withdrawn) The programmed computer of claim 71, further comprising means for creating an additional registration record with an index number already in use to create a registration with multiple entries that span a time period.

89. (Withdrawn) The programmed computer of claim 71, further comprising means for creating a registration record without said index number to accommodate registrations of a non-indexed type in the same registration record database as those of the indexed type.

90. (Withdrawn) The programmed computer of claim 71, further comprising means for occasionally recalculating certificate fingerprints in order to provide an indication of database corruption.

91. (Withdrawn) The programmed computer of claim 71, further comprising means for continuously recalculating certificate fingerprints in order to provide an indication of database corruption.

92. (Withdrawn) The programmed computer of claim 81, further comprising means for transmitting by the trade secret accounting system to the trade secret registration system the certificate identifier of the previous certificate with a new request to provide a check of the database integrity to provide an indication of database corruption.

93. (Withdrawn) The programmed computer of claim 81, further comprising means for transmitting by the trade secret registration

system to the trade secret accounting system previously granted certificates as a request to verify these certificates and return an indication of their status.

94. (Withdrawn) The programmed computer of claim 81, further comprising:

- a) means for continuously recalculating certificate fingerprints in order to provide an indication of database corruption;
- b) means for transmitting by the trade secret accounting system to the trade secret registration system the certificate identifier of the previous certificate with a new request to provide a check of the database integrity to provide an indication of database corruption; and
- c) means for determining the location of the data corruption from the said return indications.

95. (Withdrawn) The programmed computer of claim 81, further comprising:

- a) means for continuously recalculating certificate fingerprints in order to provide an indication of database corruption;
- b) means for transmitting by the trade secret registration system to the trade secret accounting system previously granted certificates as a request to verify these certificates and return an indication of their status; and
- c) means for determining the location of the data corruption from the said return indications.

96. (Withdrawn) A method of protecting a trade secret comprising the steps of:

- a) applying a plurality of generally accepted legal criteria to a content of the trade secret;
- b) assigning a value under each criterion; and
- c) generating one or more metrics from the assigned values through the use of logical and mathematical processes, thereby

allowing the comparison of results with predetermined threshold values.

97. (Withdrawn) The method of protecting the trade secret as in claim 96 further comprising creating an application fingerprint from a content of the trade secret.

98. (Withdrawn) The method of protecting trade secrets as in claim 97 wherein the step of creating the application fingerprint further comprises processing the content of the trade secret using a deterministic one-way algorithm.

99. (Withdrawn) The method of protecting trade secrets as in claim 97 further comprising transferring the application fingerprint from a creator of the trade secret to a trusted third party.

100. (Withdrawn) The method of protecting trade secrets as in claim 99 further comprising creating a certificate fingerprint from the application fingerprint by the trusted third party.

101. (Withdrawn) The method of protecting trade secrets as in claim 100 further comprising transmitting the certificate fingerprint from the trusted third party to the creator of the trade secret as a trade secret certificate.

102. (Withdrawn) The method of protecting trade secrets as in claim 96 wherein the step of applying the plurality of generally accepted legal criteria further comprises using the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts.

103. (Withdrawn) The method of protecting trade secrets as in claim 96 wherein the step of assigning the value further comprises assigning numeric values, such as on a scale of one to five or such

as on a scale of zero to ten.

104. (Withdrawn) The method of protecting trade secrets as in claim 96 wherein the step of generating one or more metrics further comprises comparing the assigned values with predetermined threshold values.

105. (Withdrawn) An apparatus for protecting a trade secret comprising:

- a) means for applying a plurality of generally accepted legal criteria to a content of the trade secret;
- b) means for assigning a value under each criterion; and
- c) means for generating one or more metrics from the assigned values through the use of logical and mathematical processes, thereby allowing the comparison of results with predetermined threshold values.

106. (Withdrawn) The apparatus for protecting the trade secret as in claim 105 further comprising means for creating an application fingerprint from a content of the trade secret.

107. (Withdrawn) The apparatus for protecting trade secrets as in claim 106 wherein the means for creating the application fingerprint further comprises means for processing the content of the trade secret using a deterministic one-way algorithm.

108. (Withdrawn) The apparatus for protecting trade secrets as in claim 106 further comprising means for transferring the application fingerprint from a creator of the trade secret to a trusted third party.

109. (Withdrawn) The apparatus for protecting trade secrets as in claim 108 further comprising means for creating a certificate fingerprint from the application fingerprint by the trusted third

party.

110. (Withdrawn) The apparatus for protecting trade secrets as in claim 109 further comprising means for transmitting the certificate fingerprint from the trusted third party to the creator of the trade secret as a trade secret certificate.

111. (Withdrawn) The apparatus for protecting trade secrets as in claim 105 wherein the means for applying the plurality of generally accepted legal criteria further comprises means for using the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts.

112. (Withdrawn) The apparatus for protecting trade secrets as in claim 105 wherein the means for assigning the value further comprises means for assigning numeric values, such as one to five or a scale of zero to ten.

113. (Withdrawn) The apparatus for protecting trade secrets as in claim 105 wherein the means for generating one or more metrics further comprises means for comparing the assigned values with predetermined threshold values.

114. (Withdrawn) An apparatus for protecting a trade secret comprising:

- a) an information processor adapted to apply a plurality of generally accepted legal criteria to a content of the trade secret;
- b) an input device adapted to assign a value under each criterion; and
- c) an arithmetic processor adapted to generate one or more metrics from the assigned values through the use of logical and mathematical processes, thereby allowing the comparison of results with predetermined threshold values.

115. (Withdrawn) The apparatus for protecting the trade secret as in claim 114 further comprising an application processor adapted to create an application fingerprint from a content of the trade secret.

116. (Withdrawn) The apparatus for protecting trade secrets as in claim 114 further comprising a communication processor adapted to transfer the application fingerprint from a creator of the trade secret to a trusted third party.

117. (Withdrawn) The apparatus for protecting trade secrets as in claim 116 further comprising a certificate processor adapted to create a certificate fingerprint from the application fingerprint by the trusted third party.

118. (Withdrawn) The apparatus for protecting trade secrets as in claim 114 wherein the arithmetic processor further comprises a comparator processor adapted to compare the assigned values with predetermined threshold values.

119. (Previously Presented) A programmed computer method based upon the six factors of a trade secret from the First Restatement of Torts for identifying trade secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets comprise information, said method implemented by the programmed computer to effect the following steps:

a) the programmed computer providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees

and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others;

b) the programmed computer receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors;

c) the programmed computer calculating a metric from the received numerical score values under the six factors; and

d) the programmed computer determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value.

120. (Previously Presented) A programmed computer method based upon the six factors of a trade secret from the First Restatement of Torts for identifying trade secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets comprise information, said method implemented by the programmed computer to effect the following steps:

a) the programmed computer providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with

which the information could be properly acquired or duplicated by others;

b) the programmed computer receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors;

c) the programmed computer calculating a metric from the received numerical score values under the six factors;

d) the programmed computer ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric.

121. (Previously Presented) A programmed computer based upon the six factors of a trade secret from the First Restatement of Torts for identifying trade secrets within a plurality of potential trade secrets of a business, where each of the plurality of potential trade secrets comprise information, said programmed computer comprising:

a) means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and its competitors; (5) the amount of time, effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others;

b) means within the programmed computer for receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors;



c) means within the programmed computer for calculating a metric from the received numerical score values under the six factors;

d) means within the programmed computer for determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value.

122. (Previously Presented) A method based upon the six factors of a trade secret from the First Restatement of Torts for providing documentation, analysis, auditing, accounting, protection, and other management relating to an existence, ownership, access and employee notice of a plurality of the trade secrets of an organization, said method comprising the following steps:

a) accepting six inputs as to the extent that a trade secret meets each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business guard the secrecy of the information; (4) the value of the information to the business and to its competitors; (5) the amount of effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others;

b) providing a corresponding numerical score value to each of the six inputs;

c) calculating a single metric for the trade secret from the six numerical scores using logical and mathematical processes.

d) repeating steps a, b, and c for each remaining trade secret of the plurality of trade secrets; and

e) ranking the plurality of trade secrets in ascending order or descending order of the calculated metric.

123. (Previously Presented) A method based upon the six factors of a trade secret from the First Restatement of Torts for providing documentation, analysis, auditing, accounting, protection, and other management relating to an existence, ownership, access and employee notice of a plurality of the trade secrets of an organization, said method comprising the following steps:

a) accepting six inputs as to the extent that a trade secret meets each of the six factors of a trade secret from the First Restatement of Torts, said six factors including (1) the extent to which the information is known outside of the business; (2) the extent to which it is known by employees and others involved in the business; (3) the extent of measures taken by the business to guard the secrecy of the information; (4) the value of the information to the business and to its competitors; (5) the amount of effort or money expended by the business in developing the information and (6) the ease or difficulty with which the information could be properly acquired or duplicated by others;

b) providing a corresponding numerical score value to each of the six inputs;

c) calculating a single metric for the trade secret from the six numerical scores using logical and mathematical processes.

d) comparing the calculated metric to a threshold value.

IX. EVIDENCE APPENDIX

No evidence has been submitted with this appeal.

X. RELATED PROCEEDINGS INDEX

There are no proceedings related to this appeal.